

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court NORTHERN DISTRICT OF OHIO on the following

☒ Trademarks or ☐ Patents. (☐ the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 2011-000000	DATE FILED	U.S. DISTRICT COURT NORTHERN DISTRICT OF OHIO
PLAINTIFF BCP Imports, LLC		DEFENDANT Howard Montag Group LLC
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 3,787,219		
2		
3		
4		
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Geri M. Smith	(BY) DEPUTY CLERK Carlene Kinsey	DATE 3/9/2011
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
WESTERN DIVISION**

BCP IMPORTS, LLC))	Case No.:
148 Main Street))	
Toledo, OH 43605))	
)	Hon. Judge:
Plaintiff,))	
)	COMPLAINT
v.))	WITH JURY DEMAND
)	
HOWARD MONTAG GROUP LLC))	
2200 East Concord St))	
Broken Arrow, OK 74012))	
)	
Defendants.))	
)	

Plaintiff, BCP Imports, LLC ("Plaintiff"), by and through its undersigned attorneys, for its complaint against Defendant Howard Montag Group LLC, ("Defendant"), alleges as follows:

NATURE OF THE ACTION

1. This action has been filed by BCP Imports, LLC., located in Toledo, Ohio, to stop the infringement of its federally registered trademark SILLYBANDZ by Defendant. This is a civil action arising under the laws of the United States, specifically under 15 USC § 1125(a) (§ 43(a) of the Lanham Act) for trademark infringement and unfair competition.

PARTIES

2. BCP Imports, LLC is a limited liability corporation organized under the laws of the State of Ohio with its principal place of business at 148 Main Street, Toledo, Ohio 43605.

3. On information and belief, Howard Montag Group LLC is a limited liability corporation organized under the laws of the Oklahoma, having a place of business at 2200 East Concord St. Broken Arrow, OK 74012.

JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction pursuant to 15 USC § 1121 (actions arising under the Lanham Act), 28 USC § 1331 (actions arising under the laws of the United States), 28 USC § 1338(a) (acts of Congress relating to copyrights and trademarks), and 28 USC § 1338(b) (civil actions asserting a claim of unfair competition), 15 USC § 1116 (Injunctive Relief), and 28 USC § 2201-02 (Federal Declaratory Judgment Act).

5. Venue is proper in this District pursuant to under 28 U.S.C. §§ 1400(a) and 1391(b).

6. This Court has personal jurisdiction over Defendants. On information and belief, Defendants have conducted acts of infringement and unfair competition in this District. On information and belief, Defendants are subject to personal jurisdiction in this District as the acts complained of herein take place within this District and also due to defendant's continuous and systematic contacts with this District.

7. This Court has supplemental jurisdiction over the additional causes of action pursuant to 28 USC § 1367, as claims so related to other issues in the action that they form part of the same case or controversy.

FACTS COMMON TO ALL COUNTS

8. Plaintiff sells uniquely shaped and brightly colored elastic bands under the trademark Sillybandz which is the subject of U.S. Trademark Registration number 3,787,219 (a copy of which is attached hereto as Exhibit A).

9. Plaintiff's products are sold in clear plastic "pillow-shaped" packages with a generally rectangular label located near the top of the package. This design is a trademark which is the subject of U.S. Trademark application serial number 85158334 (a copy of which is attached hereto as Exhibit D). The packaging used by the parties is similar.

10. Plaintiff sells its product under the trademark COLLECT'EM TRADE 'EM WEAR 'EM which is the subject of U.S. Trademark Application serial number 85164979 (a copy of which is attached hereto as Exhibit C).

11. Plaintiff's products are packaged in subject matter groupings named, for

example, Sea Creatures and Western Silly Bandz. These products are copyrighted and are covered by U. S. Copyright Registrations.

12. Defendants' products are packaged in similar subject matter groupings with similar names and similar band designs. Defendants' product packages illustrate and include products which are shaped similarly to the copyrighted product designs included in Plaintiff's respectively named packages.

13. Defendant markets a group of similar designs which it calls "Water Creatures" and "Old West". These groups contain designs similar to the plaintiff's including sea horses, alligators, and sharks.

14. Defendants has gone so far as to use the mark SILLYBANDZ in its HTML Metatags so as to cause initial interest confusion. Search engines pick these words up when customers are searching for Plaintiff's trademarked and original products. See Exhibit B attached.

15. Upon information and belief the Defendant purchased a SEO program where there were articles published that hot linked "Sillybandz" to www.zanybandz.com.

16. www.zanybandz.com

17. Defendant falsely advertises and states to the press that it developed the trend and is the originator of the product. See

<http://www.tulsaworld.com/business/article.aspx?subjectid=53&articleid>

=20100510_53_0_ThePer678738. In one instance the Defendant falsely submitted claims to Wikipedia that it was the originator of these products. That false statement has since been removed by Wikipedia.

18. In one article "James Howard, president of Zanybandz, based in Oklahoma, said the idea originated in China with shaped silicone office products. He said that he suggested making them in cute shapes that would appeal to children and that the Learning Express stores in Birmingham picked up on the craze when the product started to fly off the shelves. Sales quickly went from 25 packs a month to 7,000 a month." http://www.nytimes.com/2010/04/17/nyregion/17toy.html?_r=1. This was years after the Plaintiff had created the product and been selling it. Thus defendant made false statements to consumers with the intent of taking sales from Plaintiff as a result of those

false statements.

19. Defendant falsely posted to wikipedia that "Silly Bandz are silicone rubber bands, developed by Zanybandz....".

20. Plaintiff has not authorized Defendant to use Plaintiff's marks on any products.

**COUNT 1 – TRADE MARK INFRINGEMENT
AND UNFAIR COMPETITION 15 USC § 1114 (§ 32 OF THE LANHAM ACT)
AND 15 USC § 1125(A) (§ 43(A) OF THE LANHAM ACT).**

21. Plaintiff hereby incorporates the allegations contained in paragraphs 1 through 20 above as though fully set forth herein.

22. Plaintiff's products are prominently labeled with the trademark "Collect 'em, Trade 'em, Wear 'em" and with the mark SILLYBANDZ.

23. Plaintiff owns a U.S. trademark registration for SILLYBANDZ and has a pending application for the mark "Collect 'em, Trade 'em, Wear 'em".

24. Plaintiff's trademarks Sillybandz and "Collect 'em, Trade 'em, Wear 'em." have become valuable indicators of the source and origin of Plaintiff's products.

25. Defendant owns the domain name <http://www.zanybandz.com/> and the website at <http://www.zanybandz.com/> which has prominently advertised Zany Bands and "Collect 'em, Trade 'em, Wear 'em in a manner that confuses them with Sillybandz and "Collect 'em, Trade 'em, Wear 'em owned by the Plaintiff and has thus infringed Plaintiff's rights and committed acts of infringement of a registered trademark under 15 USC § 1114 (§ 32 of the Lanham Act) and acts of unfair competition under 15 USC § 1125 (§ 43 of the Lanham Act), as Defendant's activities are likely to cause confusion or initial interest confusion, among the relevant public.

26. Defendant has used and is using meta tags or meta names "Silly Bandz" and "Silly Bands" in connection with its website to redirect consumers searching for genuine Sillybandz products to its website and is thus infringing Plaintiff's rights and committing acts of infringement of a registered trademark under 15 USC § 1114 (§ 32 of the Lanham Act) and acts of unfair competition under 15 USC § 1125 (§ 43 of the Lanham Act), as Defendant's activities are likely to cause confusion or initial interest

confusion, among the relevant public.

27. As a direct and proximate result of Defendants' infringement of Plaintiff's trademark, Plaintiff has suffered and unless enjoined will continue to suffer damages to its profits, sales, and business.

**COUNT 2 – FALSE ADVERTISING 15 USC § 1125(A)
(§ 43(A) OF THE LANHAM ACT)**

28. Plaintiff hereby incorporates the allegations contained in paragraphs 1 through 27 above as though fully set forth herein.

29. Defendant has made false or misleading statements of fact concerning his product and as to the origin of them.

30. These statements that defendant originated Silly Bandz or that its products are SillyBandz are false.

31. These statements actually deceives or tends to deceive substantial portion of intended audience.

32. The statements are material in that they will likely influence deceived customer's purchasing decisions.

33. Defendants statements were introduced into interstate commerce.

34. Defendants actions in making these false statements have caused financial injury and injury to the reputation of the Plaintiff.

35. there is some causal link between challenged statements and harm to plaintiff. Lanham Trade-Mark Act, § 43(a), 15 U.S.C.A. § 1125(a).

36. As a direct and proximate result of Defendant's False Advertising Plaintiff has suffered and unless enjoined will continue to suffer damages to its profits, sales, reputation, loss of goodwill and business.

**COUNT 3 – FEDERAL ANTIDILUTION
TRADEMARK ACT 15 USC § 1125(A)**

37. Plaintiff hereby incorporates the allegations contained in paragraphs 1 through 36 above as though fully set forth herein.

38. Plaintiff has sold millions of its products all over the world and has

spawned dozens of imitators since its inception.

39. Plaintiff's products are worn by movie stars who publicize Plaintiff's products.

40. Plaintiff's marks are famous and distinctive, and that defendant's use of the mark was in commerce. All of defendant's legitimate use and trademark use if any began after Plaintiff's mark had become famous.

41. Defendant's use has caused dilution of the distinctive quality of Plaintiff's marks and caused actual harm to the Plaintiff and its marks. Defendant's actions have caused financial loss, weakened the response to its own advertising and promotion and caused it to lose goodwill as well as injury to its reputation.

42. Defendant has acted maliciously with purpose and bad faith as evidenced by its false claims that it is the originator of Silly Bandz and that its products are Silly Bandz.

43. As a direct and proximate result of Defendant's Dilution Plaintiff has suffered and unless enjoined will continue to suffer damages and injury under 15 U.S.C.A. § 1125(c)(1), and unless enjoined will continue to suffer such irreparable harm.

COUNT 4 – CANCELLATION OF DEFENDANT'S TRADEMARK APPLICATIONS

44. Plaintiff hereby incorporates the allegations contained in paragraphs 1 through 43 above as though fully set forth herein.

45. Defendant has applied for a US trademark registration for the mark ZANY BANDZ. (Serial Number 85061425)

46. In the process of making this application it has ignored Plaintiff's mark rights in SILLY BANDZ even though it clearly had knowledge of it.

47. Likewise the Defendant has made false statements to the PTO in the obtaining or effort to obtain this registration. This Fraud upon the PTO as well as other factors including Plaintiff's prior mark rights and the dilution being caused, prohibit Defendant from obtaining a registration.

48. Defendant's planned and existing use of the mark creates not just a

likelihood of confusion, but actual and substantial consumer confusion, as to the sources of the respective goods and services of the Plaintiff and Defendant.

49. This Court has authority to determine the right to registration of a trademark and order its cancellation under Section 37 of the Lanham Act, 15 U.S.C. §1119 and 15 U.S.C. § 1064.

50. Plaintiff is entitled to pre-empt the USPTO ruling on Defendant's trademark application and either stay the USPTO registration proceeding or have it decided by this court.

51. Based upon the foregoing Plaintiff seeks a stay of the PTO proceeding until the case *sub judice* is resolved.

52. Plaintiff, as first user of the SILLY BANDZ mark, therefore seeks a stay of the registration action serial number 85061425 until this matter is resolved and the cancellation of Defendants U.S. Trademark Applications after this action is final pursuant to the Court's authority under 15 U.S.C. §1119 and 15 U.S.C. § 1064.

COUNT 5 – DILUTION UNDER OHIO LAW

53. Plaintiff hereby incorporates the allegations contained in paragraphs 1 through 52 above as though fully set forth herein.

54. Defendant's use of the confusingly similar ZANY BANDZ mark and the identical "Collect 'em, Trade 'em, Wear 'em." mark operate to whittle away and disperse in the mind of the public the unique identity of the Plaintiff's marks.

55. The SILLY BANDZ and "Collect 'em, Trade 'em, Wear 'em" marks are distinctive and strong marks.

56. Defendant's use of a confusingly similar trademarks and domain name and website have diluted the strength of the Plaintiff's mark by blurring and diminishment.

57. Defendants' actions have appropriated and exploited the Plaintiff's mark.

58. The Defendant's marks are substantially similar marks or identical to Plaintiff's marks.

59. As a direct and proximate result of the actions of Defendant, Plaintiff has been damaged in an amount to be proven at trial and is entitled to recovery of actual

damages, and punitive damages. Plaintiff further seeks a preliminary and permanent injunction stopping the Defendant from using the infringing marks, and attorneys fees and the costs of this action.

COUNT 7 – DECEPTIVE TRADE PRACTICES R.C. 4165.02

60. Plaintiff hereby incorporates the allegations contained in paragraphs 1 through 59 above as though fully set forth herein.

61. Defendant has engaged in a deceptive trade practice as it has, in the course of the its business, it has:

62. Passed off goods or services as those of another.

63. Caused a likelihood of confusion or initial interest confusion, or misunderstanding as to the source, sponsorship, approval, or certification of its goods (ZanyBandz).

64. Represented that goods or services have sponsorship, approval, characteristics, ingredients, uses, benefits, or quantities that they do not have or that a person has a sponsorship, approval, status, affiliation, or connection that the person does not have.

65. Represented that goods or services are of a particular standard, quality, or grade, or that goods are of a particular style or model, if they are of another.

66. Disparaged the goods, services, or business of another by false representation of fact.

67. As a result of Defendant's violation of R.C. 4165.02, Plaintiff is entitled to damages and injunctive relief pursuant to R.C. 4165.03.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff demands judgment and relief against Defendants and respectfully requests that this Court:

- A. Enter judgment for Plaintiff on all Counts of the Complaint;
- B. Find that Defendants have engaged in unfair competition in violation of 15

USC § 1116, 1125(a) and 1125(c);

C. Due to the irreparable harm being caused by the Defendant that it be preliminarily and permanently enjoined, restrained and forbidden, and all of Defendants' principals, servants, officers, directors, partners, agents, representatives, shareholders, employees, affiliates, successors and assignees and all others acting in privity, concert or participation with Defendants, from:

(i). using any false designation of origin or false description or statements which can or is likely to lead the trade or public, or individual members thereof, to mistakenly believe that any product advertised, promoted, offered or sold by Defendants is sponsored, endorsed, connected with, approved by, or authorized by Plaintiff;

(ii). assisting, aiding or abetting another person or business entity in engaging or performing any of the activities enumerated in sub-paragraph (i) above;

D. Pursuant to 15 USC § 1118 (§ 36 of the Lanham Act), enter an order requiring Defendants and all of its principals, servants, officers, directors, partners, agents, representatives, shareholders, employees, affiliates, successors, assignees and all others acting in privity, concert or participation with Defendants, who receive actual notice of said order, to deliver up all goods and products, signs, articles, items, and promotional, advertising, and any other printed materials of any kind bearing on Plaintiff's trademarks or other confusingly similar marks to the Court for destruction;

E. Pursuant to 15 USC § 1117(a), (§ 35 of the Lanham Act), award Plaintiff in excess of \$75,000, including, but not limited to, (1) the Defendants' profits, (2) any damages sustained by the Plaintiff, and (3) the costs of the action plus interest as a result of Defendants' infringements and unfair competition;

F. Pursuant to 15 USC § 1117(a), find that this is an exceptional case and award Plaintiff reasonable attorneys' fees;

G. Pursuant to 15 USC § 1117(b), award the Plaintiff three times the amount of actual damages or profits by virtue of the willful nature of the Defendants' acts.

H. Order an accounting by Defendants of any profits derived in any way from Defendants' wrongful acts.

I. Award such other and additional relief, at law or equity, as may be warranted

by Plaintiff's claims as set forth above, or as amended at a later time, by the the facts and the law determined to apply in this matter.

Respectfully submitted,

/s/ Anthony J. DeGidio
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JURY DEMAND

Plaintiff hereby demands trial by jury on all issues triable to a jury.

/s/ Anthony DeGidio
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Attorney for Plaintiff